

8 face of the elongated retainer strip 70 and accepts the rear edge 76 of countertop 68. An
9 upwardly extending tongue 78 is formed along the top of the retainer strip 70 and is spaced
10 outwardly from wall 72. Tongue 78 has a flat front surface 80 and a beveled rear portion 82. A
11 workman familiar with the construction as just described, merely reverses the assembly and
12 removes the rear edge 76 of countertop 68 from the retainer strip 70, which itself is readily
13 disassembled once the backsplash 84 is lifted off the retainer strip.

14 The countertop 68 is then carried bodily out of the kitchen and to the vehicle or
15 truck. It is placed on the replacement slab 86, of marble or composite stone, as the case may be,
16 and used as a template, and as best understood from Fig. 4, a cutting guideline 88 is drawn, either
17 manually or by pantograph, or edge-sensing means, such as by a commercially available
18 electronic templating device sold under the designation "Proliner," by Innovative Marble & Tile,
19 Inc. of Hauppauge, New York 11788.

20 The replacement slab 86 with the applied cutting guideline 88 is then cut to size
21 and shape by the cutting saw 1, and the resulting replacement kitchen countertop 90 carried back
22 into the kitchen of Fig. 3 and assembled in place.

 The examiner argues that applicant's method differs from that of Dubue only in
that in Dubue, "the slab is carried into the dwelling, the original countertop is used to mark the

template (i.e. the cutting guideline) thereon, and the marked slab is returned to the truck for cutting.”

The applicant challenges the accuracy of this. To serve as a template it is well known that the original countertop must be placed on top of the slab so that the slab, due to its oversize, presents a peripheral edge extending beyond the smaller-sized original countertop and in which peripheral edge the demarcating of the cutting guideline is placed.

The Dubue slab carried into the dwelling therefore cannot be placed on top of the original countertop, but would require a removal from its support of the original countertop and the placement on said support of the slab followed by the placement thereover of the original countertop, in order to use the templating process of producing the cutting guideline.

The original countertop would then have to be removed from the marked slab, since the weight of the two would be a burden to carry out to the truck, and only the marked slab carried out to the truck at this point. However, carrying the original countertop to the truck for disposal in a subsequent trip cannot be avoided.

The marked slab would be cut to size in the truck, using only the guideline and not the physical presence of the peripheral edge of the original countertop tracking said guideline, and the thusly cut slab carried for the second time back to the dwelling and installed in place.

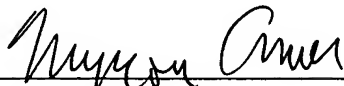
In contrast, applicant’s method, inter alia, uses to advantage the support of the cutting saw to provide an underlying position to the slab in the truck to carry out the template use of the original countertop, and requires only one carrying trip each of the slab and of the kitchen countertop, the former into the dwelling after the lessening of its weight by trim not used, and the latter being carried out to the truck and thus in the truck in condition to be disposed of.

All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Furthermore, it is well established that the materials or apparatus on which a process is carried out must be accorded weight in determining the obviousness of that process. See In re Pleuddemann, 910 F.2d 823, 825-28, 15 USPQ2d 1738, 1740-42 (Fed.Cir. 1990); In re Kuehl, 475 F.2d 658, 664-65, 177 USPQ 250, 255 (CCPA 1973); Ex parte Leonard, 187 USPQ 122, 124 (Bd. App. 1974). It is submitted that the case law clearly establishes that the position of the examiner in this case is in error.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. §103(a) should be withdrawn.

Respectfully,

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Dated: July 22, 2005

REVISED AMENDMENT PRACTICE

Claim 1. (Currently amended) A method for a factory to replace a jobsite article of manufacture comprising the steps of:

- A. designating for replacement a marble kitchen countertop of a known size constituted by a peripheral edge thereabout in a known dwelling constituting said jobsite;
- B. ~~using a truck having~~ transporting to said jobsite in a truck
 - (1) a marble-cutting saw ~~thereon~~ having
 - (a) a marble cutting means; and
 - (b) a marble-support means in cutting relation to said marble cutting means; and
- ~~C. (2) loading upon said truck~~ a slab of marble from a factory characterized in having confines exceeding said known size of said kitchen countertop; in supported relation upon said marble-support means;
- ~~D. — using in transportation said truck from said factory to said jobsite;~~
- ~~E. — setting up said marble slab in cutting relation to said marble cutting saw;~~
- ~~F. — transferring~~
- C. removing said kitchen countertop designated for replacement from its location in said dwelling;
- D. ~~to a position~~ positioning said thusly removed kitchen countertop in superposed relation upon and within said confines of said marble slab; so as to present for

demarcation a peripheral edge oversize of the slab relative to said kitchen countertop;

~~G.~~

E. demarcating, by using as a template said ~~transferred~~ positioned kitchen countertop, a cutting guideline ~~replacement countertop in parallel relation to~~ said kitchen countertop peripheral edge on said marble slab; and

~~H.~~

F. cutting, by using said marble-cutting saw, along said cutting guideline; and

G. replacing at said location vacated by said kitchen countertop in said dwelling
said thusly cut marble slab;

whereby there results in said marble slab at said jobsite an article of manufacture ~~for~~
serving as a replacement for said kitchen countertop removed from said dwelling.

Claim 2. (Cancelled)